IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Janne Rinne

Title: TRANSFER OF PACKET DATA IN SYSTEM COMPRISING
                MOBILE TERMINAL, WIRELESS LOCAL NETWORK AND
                MOBILE NETWORK

Appl. No.:   10/538,420

Filing Date: 10/11/2006

Examiner: Fred A. Casca

Art Unit: 2617

Conf. No.:   1831

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal in response to the Final Office Action mailed April 29, 2009, and the Advisory Action mailed July 08, 2009.

REMARKS

I.   Rejection of Claims 1-3, 6-12, 14-18, and 22-24 Under 35 U.S.C. § 102

On page 2 of the Final Office Action dated April 29, 2009, in section 3, Claims 1-3, 6-12, 14-18, and 22-24 were rejected under 35 U.S.C. 102(a) as being anticipated by technical specification 3GPP TS 23.234 V6.0.0 2004-03 (hereafter "the Technical Specification"). Applicants respectfully traverse the rejection.

Independent Claim 1 recites:

> A method of arranging transmission of packet data in a system comprising a mobile terminal, a wireless local network and a mobile network, the method comprising:
>
> signalling end-to-end service related parameters for communication between the mobile terminal and the wireless local network,
>
> communicating <u>a resource authorization identifier</u> to the mobile terminal,
>
> transmitting <u>the resource authorization identifier</u> to the mobile network via the wireless local network,
>
> receiving a request for authorization from the mobile network on the basis of <u>the resource authorization identifier</u>, and
>
> sending an authorization response to bind a tunnel between the mobile terminal and the mobile network to an end-to-end data flow of the mobile terminal wherein the authorization response comprises identification information on the end-to-end data flow and tunnel identification information identifying the tunnel.

The Examiner rejected independent Claims 8, 9, 15, 16, 17, and 22 using the same reasoning as Claim 1.

A. The Technical Specification Does Not Teach A Resource Authorization Identifier

On page 2 of the Final Office Action dated April 29, 2009, the Examiner points to various portions of the Technical Specification, in particular, figures 4.1, 5.1, 6.1-6.2B, 7.1 and 7.10, and paragraphs 5.1, 5.2, 5.7.2, 5.12, 6.2.3. <u>The citations refer to general descriptions</u> and requirements of the 3GPP system to WLAN interworking. Part 5 describes "High-level

Requirements and Principles." Part 6 describes the "Interworking Architecture." Part 7 describes "Procedures." **However, as discussed in the present application, "the 3GPP specification TS 23.234 [the Technical Specification] does not disclose how to arrange the adoption of the policy for the terminal in the WLAN-3GPP interworking system."** (Present Application, Para. [0005]; Underlining and emphasis added). The Examiner uses the same reasoning for independent Claims 1, 8, 9, 15, 16, 17, and 22.

B. The Examiner Has Not Shown That A Resource Authorization Identifier Necessarily Flows From the Teachings Of The Technical Specification

In the Advisory Action dated July 8, 2009, the Examiner argues:

> In response to arguments that 3GPP does not disclose "communicating a resource authorization identifier", the examiner respectfully disagrees. The examiner asserts that the 3GPP AAA server of the Fig. 4.1 performs such communication with the mobile terminal in order for the mobile terminal to obtain the authorization. The term "communicating" is not the same as "receiving". Therefore, the 3GPP's Fig. 4.1 and Par. 5.1 discloses the above limitation. Further, the "resource authorization identifier" is very broad. Any identifier, e.g., mobile identification or channel identifier would read on it, and in the process of gaining access to the communication network, a mobile identification **must be submitted** in order for access to be authorized and granted.

Thus, the Examiner argues that the structure of Fig. 4.1 must perform the elements of Claim 1. Hence, the Examiner is essentially making an inherency argument. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP 2112.IV.

Fig. 4.1 merely shows a simplified WLAN network model. Para. 5.1, lines 14-15 state:

> WLAN Access Authorization shall occur upon the success of the authentication procedure. It shall take into account the user's subscription profile and optionally information about the WLAN AN, such as WLAN AN operator name, WLAN AN location information (e.g., country, telephone area code, city), WLAN AN throughput (e.g., maximum and minimum bandwidth guarantees for both ingress and egress traffic). This information is used to enable use-case scenarios like location based authentication/authorization, location based billing I customer care, and location based service offerings.

Thus, Para. 5.1 merely teaches that a WLAN Access Authorization occurs. However, Para. 5.1 does not teach a specific way to perform the authorization. In particular, the Technical Specification fails to teach "a resource authorization identifier." Applicants note that there is more than one way to perform an authorization as well as different kinds of authorization; therefore, the elements of Claim 1 do not necessarily flow from the teaching of a 3GPP AAA server that obtains an authorization.

C. The Technical Specification Does Not Teach A Resource Authorization Identifier As The Term Is Used By The Applicants

Furthermore, the Technical Specification does not teach "a resource authorization identifier" as Applicants use the term. The Examiner argues that "resource authorization identifier" is very broad and that "any identifier, e.g., mobile identification or channel identifier would read on it." However, "any identifier" is not equivalent to "resource authorization identifier." Paragraph [0027] of the present application states in part: "[f]or binding the authorization decision, the PDF creates a resource authorization identifier, which may be referred to as an authorization token as in the IMS system, for the session and transmits it to the mobile station MS." Thus, the resource authorization identifier is not simply "any identifier."

D. The Technical Specification Does Not Teach Other Elements With The Requisite Level of Detail

Likewise, as argued in the Reply dated June 24, 2009, the Technical Specification does not teach "transmitting the resource authorization identifier to the mobile network via the wireless local network," "receiving a request for authorization from the mobile network on the basis of the resource authorization identifier," or "sending an authorization response to bind a tunnel between the mobile terminal and the mobile network to an end-to-end data flow of the mobile terminal wherein the authorization response comprises identification information on the end-to-end data flow and tunnel identification information identifying the tunnel" as recited by Claim 1. (Underlining added). In each element, the citations merely reveal a general description of activities related to the element but do not actually disclose the particular, detailed elements themselves. **Particularly in light of the present application, which states "the 3GPP specification TS 23.234 [the Technical Specification] does not disclose how to arrange the adoption of the policy for the terminal in the WLAN-3GPP interworking system," it is not enough to cite general description. (Present Application, Para. [0005]; Underlining added). In this case, although the Technical Specification is certainly related to the claimed subject matter, the Technical Specification does not actually disclose the actual claimed subject matter.** In an anticipatory rejection, each and every element of the claims must be shown. **Moreover, "the identical invention must be shown in as complete detail as is contained in the ... claim." (MPEP 2131).**

An anticipatory rejection cannot be properly maintained where the reference does not disclose all of the elements or does not disclose the identical invention in as complete detail as

the claims. For at least the above reasons, Applicants respectfully request withdrawal of the rejection of independent Claim 1 and independent Claims 8, 9, 15, 16, 17, and 22 which were rejected using the same arguments. Claims 2-7 include elements of Claim 1. Claims 10-14 include elements of Claim 9. Claims 18-19 include elements of Claim 15. Claims 20-21 include elements of Claim 17. Claims 23-24 include elements of Claim 22. Therefore, Applicants respectfully request withdrawal of the rejection of Claims 1-24.

II.   Rejection of Claims 4, 5, 13, 19 and 21 Under 35 U.S.C. § 103

On page 5 of the Final Office Action dated April 29, 2009, in section 4, Claims 4, 19 and 21 were rejected under 35 U.S.C. 103(a) in view of the Technical Specification. On page 7 of the Final Office Action dated April 29, 2009, in section 5, Claims 5 and 13 were rejected under 35 U.S.C. 103(a) over the Technical Specification in view of U.S. Patent Application Publication 2005/0163078 to Oba et al. Applicants respectfully traverse the rejections.

As discussed above, and in the Reply dated June 24, 2009, the Technical Specification does not disclose all of the elements and does not disclose the identical invention in as complete detail as the independent claims. For at least these reasons, Applicants respectfully request withdrawal of the rejection of Claims 4, 5, 13, 19, and 21.

In view of the foregoing, it is respectfully submitted that Claims 1-24 are in a condition for allowance.

Respectfully submitted,

Date___July 31, 2009_____   By _/Paul S. Hunter/_____

FOLEY & LARDNER LLP   Paul S. Hunter
Customer Number: 23524   Attorney for Applicant
Telephone: (608) 258-4292   Registration No. 44,787
Facsimile: (608) 258-4258